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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,035	10/01/2001	Toshihiro Hamamura	018656-251	4858
7590	10/17/2005		EXAMINER	
Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,035

Applicant(s)

HAMAMURA ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 15 is objected to because of the following reasons:

Examiner also notes that claim 15 recites "said information" on line 9. Examiner notes that the claim contains several limitations that might be considered information that should be displayed. As the claim includes only one specific recitation of "information" (e.g. "the prepayment information") Examiner finds that one of ordinary skill in the art would reasonably know that "said information" refers to "said prepayment information". Regardless, Examiner respectfully suggests replacing "said information" with "said prepayment information" in order to avoid confusion and clarify the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Levy.

Cook et al. teaches a method and system for self-service film processing that includes a mounting mechanism that mounts a medium having a prepay function (column 5, line 8 through column 6, line 3).

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Cook et al. further teaches a mounting mechanism which mounts a medium on which image data is recorded (column 6, lines 28-34 and column 6, line 62 through column 7, line 2).

Cook et al. teaches an instructing unit by which the user places an order for printing with regard to the image data recorded on the medium (column 6, lines 4 – 27).

Cook et al. further teaches a printer that prints images recorded on the medium (column 8, lines 33-47)

Cook et al. further teaches a controller that

- reads the image data recorded on the medium (column 6, lines 63-65)
- causes the printer to perform printing in response to the order via the instructing unit (column 7, lines 30-33 and column 8, lines 33-47),
- receives the printing fee, and updates the prepaid balance in the prepayment information of the medium after the printing instruction is issued from the instructing unit (column 5, lines 49-53).

Cook et al. teaches that the controller accepts a printing instruction after the image data is read from the medium (column 6, lines 8-12). Examiner notes that for the customer to make decisions regarding the digital images (such as printing) the images must first have been read by the system (controller).

Cook et al. does not teach that the image data and the prepay function are on the same medium.

Levy et al. teaches a film processing system and method including a feature in which a prepay function is placed on a medium with image data (column 3, lines 17-25). Levy et al. further teaches that this is done in order to provide enhanced and quicker operation for a consumer.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the medium on which image data is recorded of Cook et al. and the medium having a prepay function of Cook et al. by combining them into one medium as taught by Levy et al. One of ordinary skill in the art would have been motivated to modify the references in order to provide the consumers with enhanced and quicker operation.

Cook et al. further teaches the controller causing the printing of a receipt (column 5, line 23-25). Cook et al. does not teach that the receipt contains the prepaid balance. Examiner takes Official Notice that it's old and well known in the art to include payment information on a receipt in order to provide a user with a complete detail of a transaction. Further, Examiner points out that Cook et al. teaches that payment information includes prepaid balance (column 5, lines 49-53).

As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include payment information including prepaid balance on the receipt of Cook et al. in order to provide the consumers with a complete detail of the transaction.

Cook et al. does not specifically teach a mounting mechanism that prevents removal of the medium until updating of the prepaid balance is complete and nullifies the printing order if the storage medium is removed before the prepaid balance is updated.

The Examiner takes Official Notice that it's old and well known in the art for kiosks to include mechanisms to prevent the removal of medium containing prepaid data to be removed prior to updating the data and to nullify the transaction in the case where the medium is removed.

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By way of example, Examiner offers an ATM machine that takes the user's card and does not return it until after the transaction is complete. Further, Examiner notes that this is done in order to prevent damage to the medium as well as to insure that the transaction is properly completed and recorded.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Cook et al. to include a mechanism which prevents the removal of the medium until the prepaid balance is updated and that nullifies the transaction if the medium is removed prematurely. One of ordinary skill in the art would have been motivated to modify the reference in order to prevent any damage to the medium as well as to ensure that the transaction is properly complete and recorded.

Cook et al teaches a money receiving means (column 5, lines 14-16). Further, Cook et al. teaches increasing the value of a card via the input of monies (column 5, lines 53-58). Examiner notes that these teaching render obvious updating the prepaid balance and settling the printing fee by combining the prepaid balance in the storage medium and the cash added using money receiving means.

Cook et al. teaches the prepaid card also includes customer information which aids in marketing activities such as promotional activities (column 5, lines 60-65). However, Cook et al. does not specifically teach calculating fees in accordance with printing history.

Examiner takes Official Notices that providing discounted prices for bulk purchases is an old and well known promotional activity. Further, providing discount prices based on bulk

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purchases represents a calculating a price based on purchasing history (i.e. buying a lot of an item). One of ordinary skill in the art would recognize that discounts for bulk purchases are used to generate additional business and reward customer loyalty.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the promotional activities based on customer information of Cook et al. to include providing discounted prices for bulk purchases (calculate the printing fee in accordance with printing history). One of ordinary skill in the art would have been motivated to combine these references in order to generate additional business and reward customer loyalty.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Response to Arguments

Applicant's arguments filed 8/3/05 have been fully considered but they are not persuasive.

Applicant asserts that Applicants are entitled to a date of invention that is prior to the US filing date of the Cook patent, e.g. February 5, 2001.

Examiner notes Applicant is entitled to a date of invention that is prior to the effective US filing date of the Cook patent (emphasis added). Further the effective filing date of a nonprovisional application claiming the benefit of a prior provisional application is the filing date of the provisional application (see MPEP 901.4). In this case Cook's effective filing date is February 3, 2000, which is before Applicant's priority date of October 2, 2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

JAK

 10/13/05
ANDREW FISCHER
PRIMARY EXAMINER